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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,166	10/31/2003	Parris Wellman	ETH5104	6366
27777	7590	11/28/2007	EXAMINER	
PHILIP S. JOHNSON. JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			DOWE, KATHERINE MARIE	
			ART UNIT	PAPER NUMBER
			3734	
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			11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,166

Applicant(s)

WELLMAN ET AL.

Examiner

Katherine M. Dowe

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a complete response to the amendment filed 9/24/2007.
2. Claims 1-5 and 7-11 are currently pending.

Drawings

3. The amendments to the claims removing reference to the rear position and forward position are acknowledged. Accordingly the objections to the drawings as set forth in the 3/22/2007 Office Action are withdrawn.

Claim Rejections - 35 USC § 112

4. Applicant's arguments, see remarks, filed 9/24/2007, with respect to the rejection of claims 3-5 and 8 as failing to comply with the enablement requirement have been fully considered and are persuasive. The rejection of the above claims under 35 USC 112, first paragraph is withdrawn.
5. The amendments to claim 2 are acknowledged. Accordingly, the rejection of the claim under 35 USC 112, second paragraph is withdrawn.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-5 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Abele et al. (US 5,190,541). Regarding claims 1-5, 7, and 11, Abele et al. disclose a surgical device comprising a handle (14) having a slot with first and second tracks (70 and 72), a shaft (12) extending from the handle having an internal lumen (52) and a

distal opening (P; col 5, ln 7-10), an anvil (54) slidably disposed in the opening, a cutting blade (56) slidably disposed in the opening, and an actuator (76) movably disposed in the handle and operatively connected to the anvil and cutting blade. When the actuator moves along the first track (col 4, ln 58-60), the anvil moves between an open (Fig 5a) and closed position (Fig 5b); and when the actuator moves along the second track (col 4, ln 42-45), the cutting blade moves between a proximal position (Fig 5a) and distal position (Fig 5c). The anvil is moved to the closed position to capture tissue within the opening (Fig 5b; col 4, ln 32-35). The slot has a third track (52) that allows the shaft to move between a proximal and distal position when the actuator is operated. The shaft, cutting blade, and anvil are all movable relative to one another, thus the shaft (12) is in the distal position when the anvil is in the open position (Fig 5a) and the shaft is in the proximal position when the anvil is in the closed position (Fig 5b-5c).

Regarding claims 8-10, Abele et al. further disclose a lock (35) for preventing movement of the shaft relative to the handle (col 5, ln 27-32; col 6, ln 59-63), by preventing motion of actuator (36).

Response to Arguments

8. Applicant's arguments filed 9/24/2007 have been fully considered but they are not persuasive. Applicant argues the claims have been limited to a device that may be directly inserted as opposed to inserted through a trocar as required by Abele et al. The Examiner respectfully traverses the applicant's remarks. It is noted the claims merely

recite "a surgical device *for direct insertion*". Thus, it may be interpreted the claims are limited to a device that is directly inserted into the patient, whether or not it is directly inserted through a trocar.

9. In addition, the recitation of a surgical device for direct insertion has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine M. Dowe whose telephone number is (571) 272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe *Knd*
November 21, 2007



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER